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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  03-637		
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>	Application Number  10/622,146	Filed  July 16, 2003		
	First Named Inventor  Tom McCarthy			
	Art Unit  3685	Examiner  Cristina O. Sherr		
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p>  <p>This request is being filed with a notice of appeal.</p>  <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>  <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top;"><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>39,269</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></td><td style="width: 50%; vertical-align: top;"><p>_____ /George I. Lee/ Signature</p><p>_____ George I. Lee Typed or printed name</p><p>_____ 312-913-0001 Telephone number</p><p>_____ November 22, 2010 Date</p></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			<p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>39,269</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>	<p>_____ /George I. Lee/ Signature</p> <p>_____ George I. Lee Typed or printed name</p> <p>_____ 312-913-0001 Telephone number</p> <p>_____ November 22, 2010 Date</p>
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<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>				

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**(Case No. 03-637)**

In the Application of:	)	
	)	
Tom McCarthy, et al.	)	
	)	Examiner: Cristina O. Sherr
Serial No.: 10/622,146	)	
	)	Group Art Unit: 3685
Filing Date: July 16, 2003	)	
	)	Confirmation No.: 1889
For: Method and Apparatus for Distributing	)	
Media in a Pay Per Play Architecture	)	
with Remote Playback	)	
Mail Stop AF		
Commissioner for Patents		
P.O. Box 1450		
Alexandria, VA 22313-1450		

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Examiners:

Applicant respectfully requests reconsideration of the Final Office Action mailed May 21, 2010 and Advisory Action of November 3, 2010.

**I. STATUS OF THE APPLICATION**

Currently pending are claims 1-13 and 27-40 of which claim 1 is independent and the remainder of the claims are dependent. Claims 14-26, 41-44 and 46-83 were previously withdrawn and claim 45 was previously cancelled.

In the Final Office Action mailed May 21, 2010, the Examiner rejected claims 1-13 and 27-40 under 35 U.S.C. § 103(a) as being unpatentable over U.S. 5,659,350 ("Hendricks") in view of EP 1 100 266 A2 ("Gaske").

## II. DEFICIENCIES IN THE REJECTION TO THE CLAIMS

The Examiner's rejections are clearly in error for at least the reason that Hendricks in view of Gaske does not show Applicants' claimed "discovery service" to search for content and download content based on a content profile. Applicants submit that the remarks set forth in its response filed July 21, 2010 explains clearly why the rejection of the claims was in error. Applicants thus respectfully request the panel review those remarks, which are incorporated herein by reference, and consider the additional remarks below.

Applicants have examined each of the Examiner's citations to Hendricks alleged to disclose a "discovery service" and shown the factual error that these citations do not actually disclose a "discovery service." The Advisory Office Action, however, does not address Applicants' showing of why Hendricks does not disclose a "discovery service."

### A. Hendricks Does Not Disclose A "Discovery Service" to "Search for Stored Media Content and to Download Content Based On a Content Profile"

The Hendricks prior art creates on-screen program *menus* from which *the viewer selects* programs he/she wishes to watch. Hendricks "acquires viewer information on programs watched" to create an "individualized program lineup" for the viewer. Col. 3, lines 59-65. Hendricks' "menus" are "displayed on a subscriber's television by using an array of menu templates." Col. 11, lines 3-4. The subscriber can "sequence through subsequent menus" that "guide the subscriber to the selection of his choice." Col. 12, lines 63-68. The menus, however, *rely on the viewer to search for and select programming* to be downloaded and viewed.

As a result, Hendricks does not disclose a discovery service, but rather relies on the viewer to search for and select programming for download from the program menus. As the user finds and selects programming for download, Hendricks does not disclose a "discovery service"

to search for “content and to download content based on a content profile” as in claim 1. Rather, it is the viewer—not a “discovery service”—that searches for and downloads content.

The Examiner’s rejection relies on Hendricks columns 9, lines 62-66, column 15, lines 28-55 and column 16, lines 36-45 as disclosing the claimed “discovery service.”

4. Applicant argues, regarding claim 1, as currently amended, that nothing in the cited prior teaches, discloses or suggests “a discovery service, provided on the first or second platform operable to search for stored media content and to download content based on a content profile.”

5. Examiner respectfully disagrees. Attention is directed to Hendricks at col 9 ln 66-62. Also, col 15 ln 28-55 col 16 ln 10-22, col 16 ln 36-45.

Final Office Action, May 21, 2010, page 2. Despite the Examiner’s reliance, these citations do not disclose a “discovery service” that both searches for and downloads content. Applicants’ response to the Final Office Action points out in detail the deficiencies of each of the Examiner’s citations to Hendricks, which the Examiner has not responded.

#### **1. Column 9 of Hendricks Does Not Disclose a “Discovery Service”**

Column 9 of Hendricks does not disclose a “discovery service.” Rather, it refers to network controller 214 that “enables the delivery system to adapt the specific requirements of the individual set top terminals 220.” The passage explains this enables “on the fly programming” changes to provide specialized TV services such as split screen, interactive TV, etc., not a discovery service to search for and download content:

In other words, the network controller 214 is able to perform ‘on the fly programming’ changes. With this capability, the network controller 214 can handle sophisticated local programming needs such as, for example, interactive television, split screen video and selection of different foreign languages for the same video.

Col. 9, line 66-col. 10, line 7.

Thus, column 9 of Hendricks does not disclose Applicants' claimed discovery service to search for and download content based on a content profile.

## **2. Column 15 of Hendricks Does Not Disclose a "Discovery Service"**

Similarly, the Examiner's citation to columns 15 of Hendricks also does not disclose a "discovery service." Column 15, lines 28-55 refer to "the retrieval of viewer data" obtained "from set top terminals" and "then filtering and presenting the data" in the on-screen menu. Col. 15, lines 32-34. The raw data includes "programs a user purchased and when," "what channel a specific user watched and for how long." The retrieved viewer data is used to calculate "How many viewers watched a particular program," "Peak viewing times for different categories of shows," and "Buy rates for particular menu positions." Col. 15, lines 41-55. This information is then used for "Menu creation, both automatically and manually." Col. 15, line 51.

Contrary to the Examiner's citation, column 15 of Hendricks also does not disclose a "discovery service" searching and downloading programming content as called for by Applicants' claims. The cited passage is for "retrieval of viewer data" obtained "from set top terminals" to creating programming menus to display to viewers.

## **3. Column 16 of Hendricks Does Not Disclose a "Discovery Service"**

Similarly, the Examiner's citation to column 16 also does not disclose a "discovery service." In fact, the cited passage is directed toward an "Executive Information System" to provide TV executives "an online software tool that will allow for the real-time evaluation of current product positioning" where TV executives are provided with "friendly icons" to provide "general information on the current programming sales status" without a "long learning curve and information overload." Col. 16, lines 35-44. The "graphical tools allow for analysis of current data through the use of multiple graph tool types such as line graphs, bar and pie charts.

Col. 16, lines 45-47. A discovery service for downloading program content based on a profile is not disclosed.

Paragraph 12 of the Final Rejection also argues that Hendricks discloses “downloading content based on a content profile, (e.g., col. 16, lines 45-53).” Final Office Action, May 21, 2010, page 4. Again, the cited passage describes the Executive Information System to enable a TV executive to create menus with the programming mix in the allotted time slots—it does not discuss a “discovery service” to search for and download actual program content.

**B. The Gaske Prior Art Also Does Not Disclose Or Suggest The Claimed Discovery Service**

In addition, the cited Gaske prior art is also absent the claimed “discovery service.” Gaske does not disclose or suggest a service that searches for and downloads content based on a content profile.

As such, because the references, either alone or in combination, do not show all the elements of independent claim 1, claim 1 is allowable. All the remaining pending claims 2-13 and 27-40, being dependent on claim 1 are also allowable as well.

**CONCLUSION**

Given the clear error in rejecting claims 1-13 and 27-40, Applicants respectfully request that the panel withdraw the rejections and direct that a notice of allowance be mailed.

Respectfully submitted,

Date: November 22, 2010

By: /George I. Lee/  
George I. Lee  
Registration No. 39,269